

Application No. 09/939276
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Amendment After Final
Attorney Docket No. S63.2H-9828-US01

Remarks

This Amendment is in response to the Final Office Action dated **February 4, 2004**. Claims 1 – 54 are pending in this application. Claims 9 – 16 and 18 – 54 have been withdrawn from consideration. The Office Action rejected claims 1 – 4, 6, 7 and 17 under 35 USC § 103(c) over Wang et al. (US 6443980, hereinafter “Wang”) in view of Fontaine (US 5443498); rejected claim 5 under 35 USC § 103(c) over Wang in view of Fontaine and admitted prior art; and rejected claims 1 – 4, 6 – 8 and 17 under 35 USC § 102(b) over Lodin et al. (US 5460608, hereinafter “Lodin”).

By this Amendment, claim 5 is rewritten in independent form and Applicants request withdrawal of the finality of the outstanding Office Action. Reconsideration in view of the following remarks is respectfully requested.

Claim Rejections – 35 USC § 103(c)

The Office Action rejected claims 1 – 4, 6, 7 and 17 under 35 USC § 103(c) over Wang in view of Fontaine, and rejected claim 5 under 35 USC § 103(c) over Wang in view of Fontaine and admitted prior art. These rejections are traversed.

Applicants assert that the rejection of claims under 35 USC § 103(c) is improper because 35 USC § 103(c) does not provide a statutory basis for making claim rejections. Therefore, Applicants request withdrawal of all rejections under 35 USC § 103(c).

Applicants further assert that Wang does not qualify as a prior art reference under 35 USC § 103, as both the immediate application and Wang are commonly assigned to SciMed Life Systems, Inc. of Maple Grove, MN, and both were subject to an obligation of assignment to SciMed Life Systems at the time the invention was made.

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. 35 USC § 103(c).

Thus, Wang is not available as prior art against the immediate application under 35 USC § 103, and any such rejections applying Wang are moot.

Applicants assert that removal of the Wang reference under 35 USC § 103(c) does

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not constitute acquiescence as to the validity of any rejections under 35 USC § 103 had the reference been available.

Request to Withdraw Finality of Office Action

As discussed above, the Final Office Action dated February 4, 2004 improperly rejected claim 5 under 35 USC § 103(c) and did not provide any alternative grounds for rejection. As such, the Final Office Action has not properly addressed the disposition of all of the pending claims. Applicants therefore request withdrawal of the finality of the Office Action.

Claim Rejections – 35 USC § 102

The Office Action rejected claims 1 – 4, 6 – 8 and 17 under 35 USC § 102(b) over Lodin. These rejections are traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference” (MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Applicants assert that Lodin does not disclose or suggest a first tubular member and a second tubular member, “a portion of the first tubular member being welded to a portion of the second tubular member” as recited in independent claim 1.

Lodin discloses a catheter having a coaxial shaft 12 and a balloon 50. The coaxial shaft 12 includes an outer shaft 20 and an inner shaft 40. See column 4, line 67 – column 5, line 8.

Lodin does not discuss any form of securement between the inner shaft 40 and the outer shaft 20, although Lodin does disclose securement between a shaft portion and various other elements of the invention, such as a balloon 50, a marker band 80 or a reinforcing means such as a stainless steel coil 60. See column 5, line 57 – column 6, line 3. However, the method of securement disclosed is limited to using an adhesive. See, for example, column 5, lines 51 – 53. Lodin does not disclose or suggest any welding techniques or the use of welding to secure any of the elements of the catheter.

Therefore, Applicants submit that independent claim 1 is not unpatentable under 35 USC § 102 over Lodin. Claims 2 – 4, 6 – 8 and 17 depend from independent claim 1 and are

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not unpatentable for at least the reasons discussed with respect to claim 1. Accordingly, Applicants request withdrawal of the rejections under 35 USC § 102.

Conclusion

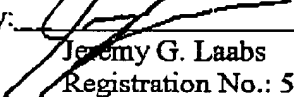
Based on at least the foregoing remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1 – 8 and 17 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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